

II. Rejections under 35 U.S.C. § 103

A. Henkel in view of Tsujino

Claims 1-27, 30-34, and 37-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel (WO 92/13824) in view of Tsujino (U.S. Patent No. 4,961,925) for the reasons set forth on pages 3-5 of the Office Action. Applicant respectfully traverses the rejection for the following reasons.

The present invention, as recited in claim 1, for example, is directed to a composition for oxidation dyeing of keratin fibers, comprising at least one first oxidation base chosen from 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane and acid-addition salts thereof, at least one second oxidation base chosen from a recited list of bases, and at least one coupler. The invention is also drawn to a process for oxidation dyeing of keratin fibers (see claim 33, for example) and multi-compartment dyeing kits (see claims 55 and 56, for example) using the inventive dyeing composition

Henkel discloses the use of 2,5-diaminophenoxy-oxaalkanes as useful developer compounds for the production of oxidation dyes. Henkel specifically discloses 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane as a preferred oxidation base. However, as admitted by the Examiner, although Henkel teaches generally that other known oxidation dyes or direct dyes can be used to vary the nuances of color, Henkel does not teach or exemplify a second oxidation base as presently claimed and further, with respect to claims 52-54, does not disclose any oxidizing agent other than hydrogen peroxide. Office Action, page 3, last line, to page 4, line 1. The Examiner also correctly notes that Henkel fails to teach the claimed kits. Office Action, page 4, line 2.

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To remedy the deficiencies of Henkel, the Examiner relies on Tsujino's teachings of dielectron reducing oxidase as an improved oxidizing agent to be used in oxidative hair dyeing in place of the conventional hydrogen peroxide. The Examiner also points to Tsujino's teaching of oxidation bases, overlapping with those presently claimed, as "conventional." Office Action, page 4, lines 3-7.

The Examiner further alleges that it would have been obvious to one of ordinary skill in the art to add a second oxidation base to Henkel's exemplified compositions in the claimed amounts, because Henkel teaches that any conventional oxidation bases may be added and Tsujino teaches that bases falling within those presently claimed are conventional. Finally, the Examiner contends that it would have been obvious to use uricase in place of the hydrogen peroxide oxidant used by Henkel. Office Action, paragraph bridging pages 4-5.

Applicant disagrees. For a prima facie case of obviousness to be established, there must be, *inter alia*, a suggestion or motivation in the references themselves or in the art to modify the reference or combine reference teachings. See M.P.E.P. § 2143. Evidence of a suggestion or motivation to modify or combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Here, neither Henkel nor Tsujino teaches or exemplifies the use of two oxidation bases, let alone the combination of a very specific base (the 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane) with another base. Henkel's passing mention of the possibility of enhancing color by adding another oxidation dye or a direct dye is too general to serve as motivation to modify the reference itself, even when considered in light of Tsujino's statement that the dyes falling within the scope of our second oxidation

base are conventional. The invention of Tsujino is the use of enzymes as alternative oxidizing agents for hydrogen peroxide, and Tsujino is merely teaching the skilled artisan that conventional oxidation bases can be used in conjunction with these oxidases. There is no suggestion or motivation gleaned from Tsujino that a second oxidation base would specifically benefit the 2,5-diaminophenoxy-oxaalkanes of Henkel. Further, none of this information qualifies as the "clear and particular" evidence required under the law to combine reference teachings. See *Dembiczak, supra*.

Because the cited art, taken alone or in combination, fails to teach the use of two oxidation bases in hair dyes where one oxidation base is 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane, the Examiner has failed to show the requisite motivation for combining the references, and accordingly has failed to make a *prima facie* case of obviousness. Applicant therefore respectfully requests withdrawal of this rejection.

B. Andrillon in view of Henkel

Claims 1-7, 9-13, 15-38, 41-53 and 55-56 are rejected under 35 U.S.C. §103 over Andrillon (U.S. Patent No. 4,065,255) in view of Henkel (WO 92/13824) for the reasons set forth on pages 5-7 of the Office Action. Applicant respectfully traverses the rejection for the following reasons.

Andrillon discloses dye compositions containing a very specific coupler in combination with a conventional oxidation base. Andrillon also teaches the use of two or more oxidation bases in combination with its coupler. See, e.g., col. 3, lines 16-21, and example nos. 12, 13 and 18 at col. 8-9. Andrillon does not teach 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane or any phenoxy oxa-alkanes, so the Examiner cites Henkel to remedy this deficiency. The Examiner apparently believes that the

combination is supported by Andrillon's teaching that mixtures of oxidation bases may be used, and Henkel's teaching that "the claimed first oxidation base results in... good fastness properties, a result specifically desired by Andrillon." Office Action, page 6, last 2 lines.

Applicant does not agree. While Andrillon's teaching may support the broad idea that more than one oxidation base can be used in hair dye compositions, there is no teaching or suggestion in either reference that 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane will specifically benefit from the addition of another oxidation base. This point is further supported by the present specification, which recites that the colorations obtained in the prior art by using 2,5-diaminophenoxyoxaalkanes are not entirely satisfactory, and show insufficient resistance to various treatments to which the hair may be subjected, and/or to the action of light. See specification at page 2, lines 10-14. The addition of a second oxidation base to 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane "surprisingly and unexpectedly" resulted in intense colorations with improved resistance properties. See specification at page 2, line 15 to page 3, line 2. This result would not have been expected from the teachings of Andrillon and Henkel, neither of which teaches or suggests, or even recognizes, the advantages of combining 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane with a "second suitably selected oxidation base" and a coupler. See specification at page 2, line 17.

Finally, Applicant takes issue with the Examiner's statement at page 7 of the Office Action that "Andrillon's teaching of separate dye and oxidant compositions suggests their storage in conventional multipart devices and kits as claimed." Andrillon does teach processes of dyeing hair where the dye and oxidizing compositions are

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added separately to the hair, but kits per se are neither taught nor suggested, and to make this contention, the Examiner could only be relying on improper hindsight.

Thus, the combination of Andrillon and Henkel fails to meet the "clear and particular" standard articulated in *Dembiczak* for the level of evidence needed to show the presence of motivation to combine reference teachings. Without a showing of motivation to combine reference teachings, the requirements for a *prima facie* case of obviousness have not been met, and the rejection should be withdrawn.

III. Conclusion


In view of the foregoing, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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